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|---|---------------|----------------------|---------------------|------------------|
| APPLICATION NO.   | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/670,572  | 09/26/2003    | Koma Morita          | 117347              | 2332             |
| 25944   | 7590          | 02/04/2009           | EXAMINER            |                  |
| OLIFF & BERRIDGE, PLC<br>P.O. BOX 320850<br>ALEXANDRIA, VA 22320-4850 |               |                      | GORT, ELAINE L      |                  |
| ART UNIT  | PAPER NUMBER  |                      |                     |                  |
|   | 3687          |                      |                     |                  |
| MAIL DATE   | DELIVERY MODE |                      |                     |                  |
| 02/04/2009  | PAPER         |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |
|------------------------------|--------------------------------------|-------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/670,572 | <b>Applicant(s)</b><br>MORITA, KOMA |
|                              | <b>Examiner</b><br>Elaine Gort       | <b>Art Unit</b><br>3687             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 28 November 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 9/26/03
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 7-9 recite method steps, not within the technological arts. A process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Neither of these requirements are met by the claims, therefore the claims does not qualify as a statutory process and do not positively recite the subject matter that is being transformed, by identifying the material that is being changed to a different state.

In re Bilski Fed. Cir. 2008, 2007-1130.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim1 recites the limitation "the executed processings" in line 8. There is insufficient antecedent basis for this limitation in the claim.

It is unclear in claim 1 line 22 what is meant by "an accounting amount determination unit for determining the calculated fees as an accounting amount".

Claim 3 recites the limitation "the executed processings" in line 4. There is insufficient antecedent basis for this limitation in the claim.

It is unclear in claim 3 line 12 what is meant by "an accounting amount determination unit for determining the calculated fees as an accounting amount".

Claim 7 recites the limitation "the executed processings" in line 4. There is insufficient antecedent basis for this limitation in the claim.

It is unclear in claim 7 line 11 what is meant by "an accounting amount determination unit for determining the calculated fees as an accounting amount".

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3 and 7, as best understood, is rejected under 35 U.S.C. 102(e) as being anticipated by Savage et al. (US Patent 7,236,950).

Savage et al. discloses the claimed charging apparatus for charging for each predetermined processing which a process apparatus executes (such as charging for telephone, retail and Internet services provided by various apparatus, abstract. Such as supply chain vendors processing systems 186 and shown as 140 in figure 3), where the process apparatus generates process information indicating contents of executed processings (such as telephone usage, retail purchases, or internet services) and status information indicating the execution status of the processings (such as order status information, column 12, lines 42+), the charging apparatus comprising:

An information reception unit for receiving the process information and the status information (such as the database 136 that receives product/service information, pricing information and order status from the vendor's systems, column 14 lines 37+);

A fee calculation unit for calculating a fee for each executed processing on the basis of the received process information (for example Supply chain vendors provide rates for their fees that they calculate, based on user's contracts or agreements, column 16 lines 15+);

An accounting amount determination unit for determining the calculated fees as an accounting amount when the received process information indicates that the executed processings are completed normally (bill aggregator 124 validates charges, construed to be determining that the processings are completed "normally" and the calculated fee amount is used on the combined bill, otherwise a correction would be made, col. 11, lines 25+); and

A charging unit for executing a charging processing on the basis of the determined accounting amount (bill aggregator charges the customers for the processing based on the accounting amount, 142 and 164).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 2, 4, 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savage et al. (US Patent 7,236,950) in view of South China Morning Post ("Lawmakers 'Suffer from Amnesia' over Dollar Peg").**

Savage et al. discloses the claimed system/apparatus but is silent regarding changing fees for accounting when processing is not completed normally. South China Morning Post teaches that it is known in the art of customer service to adjust fees with discounts for accounting when processing is not completed normally, such as a telephone call is dropped or the reception quality is poor, to provide users compensations for poor service. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system/apparatus of Savage et al. with the adjustments as taught by South China Morning Post, in order to provide customers compensation for improperly processed orders.

**9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savage et al. (US Patent 7,236,950) in view of Levantovsky (US 2002/0163654).**

Savage et al. discloses the claimed system/apparatus but is silent regarding where the processing is for printing processing for printing bitmap data. Levantovsky teaches that it is known in the art of services to process for printing bitmap data to simulate increased printer resolutions (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system/apparatus of Savage et al. with the printing processing of bitmap data as taught by Levantovsky, in order to provide customers the ability to print documents with a simulated resolution.

Examiner also notes that functional recitation(s) used in apparatus claims (e.g. "where processing includes printing processing for printing the bitmap data" as recited in claim 5) are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on 571/272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

Elaine Gort  
Primary Examiner  
Art Unit 3687

2/1/2009